

III. REMARKS

Claims 1-33 are pending in this application. By this amendment, claims 1, 10, 15, 23 and 32 have been amended. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 1-33 are rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Claims 1-33 are rejected under 35 U.S.C. §112, first paragraph, as allegedly not being enabling. Claims 1-9 and 15-33 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1, 3-5, 11, 12, 15, 17, 19, 21, 23, 25, 26 and 30 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Guinta *et al.* (U.S. Patent No. 6,161,101), hereafter “Guinta,” in view of Curtis, Bill; Hefley, William E.; Miller, Sally; “People Capability Maturity ModelSM;”, Sept 1995, Software Engineering Institute, CMU/SEI-95-MM-02, sections O, L1-L4, hereafter “Curtis.” Claims 2, 7-10, 14, 16, 22, 24, 27 and 31-33 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Guinta in view of Curtis. Claims 6, 13, 20 and 29 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Guinta in view of Curtis. Claims 18 and 28 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Guinta in view of Curtis and further in view of Bobic, Michael; Davis, Eric; Cunningham, Robert; “The Kirton

adaption-innovation inventory”, Spring 1999, Review of Public Personnel Administration, v19n2, pp. 18-31, Dialog 01991101 47253077.

A. REJECTION OF CLAIMS 1-33 UNDER 35 U.S.C. §101

The Office has rejected claims 1, 15 and 19 for allegedly being directed to non-statutory subject matter. Specifically, the Office asserts that the claimed invention does not produce a useful, concrete, and tangible result. Initially, Applicants respectfully submit that the relevant section of the United States Code recites:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title. 35 U.S.C. §101.

To this extent, the code requires that the invention be “new and useful” and not that the result be “useful, concrete, and tangible” as asserted by the Office. The USPTO has chosen, in its Interim Guidelines, to use concreteness of the result and tangibility as factors in making a determination as to whether the invention is useful. However, the Guidelines themselves state that concreteness of the result and tangibility are not dispositive in and of themselves, but merely factors in determining whether the invention is useful.

In the interest of furthering prosecution of the application, Applicants have amended claim 1 to recite “...outputting the predicted response to the technical change,” and have made similar changes to claims . Applicants assert that this amendment further directs the invention to statutory subject matter. Accordingly, Applicants request that the rejection be withdrawn.

The Office also states that the steps of the invention would produce a predicted response that is substantially different, depending on the individual that is utilizing these steps. While not

necessarily agreeing with the examiner, Applicants have amended claims 1, 10, 15, 23 and 32 to recite, "...a baseline response regarding skills and training of members of the hierarchy based on those that are needed to implement the technical change." Applicants submit that this limitation narrows the focus of the query, and, as such, provides a more predictable result with regard to the results of the query. For example, given the Office's hypothetical construction companies, two individuals testing the employees' skills and training with regard to a particular word processing program would each be able to design queries that gave similar results. Accordingly, Applicants respectfully submit that the amendment further directs the invention to statutory subject matter and requests that the rejection be withdrawn.

B. REJECTION OF CLAIMS 1-33 UNDER 35 U.S.C. §112

The Office has asserted that claims 1-33 do not satisfy the enablement requirement. Applicants respectfully submit that the amendments and arguments submitted herein with respect to the Office's rejection under 35 U.S.C. §101 satisfy this rejection as well. Accordingly, Applicants request that the rejection be withdrawn.

The Office has further asserted that claim 1-9 and 15-33 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regard as the invention. Applicants have amended claims 1, 15, 23 and 32 to recite, "...for preparing for implementing technical change in an organization." Applicants assert that these amendments further clarify the invention. Accordingly, Applicants request that the rejection be withdrawn.

C. REJECTION OF CLAIMS 1, 3-5, 11, 12, 15, 17, 19, 21, 23, 25, 26 AND 30 UNDER 35 U.S.C. §103(a) OVER GUINTA IN VIEW OF CURTIS

With regard to the 35 U.S.C. §103(a) rejection over Guinta in view of Curtis, Applicants assert that the cited references fail to teach each and every feature of the claimed invention. For example, with respect to independent claims 1, 15 and 23, Applicants submit that the cited references fail to teach or suggest performing the querying, quantifying, modifying and comparing steps in preparation for implementing a pre-defined proposed technical change in a working environment of the organization. Instead, Guinta teaches that its invention “...is particularly suited for use in connection with methods and apparatus for assessing an organization process or system.” Col. 2, lines 47-49. To this extent, the Guinta invention is used to assess an existing organization process or system. While it is true that a corrective action may occur as a result of the Guinta evaluation the corrective action is not taught as being pre-defined prior to the evaluation and the evaluation occurring in preparation for the proposed change.

Furthermore, nowhere do the cited references disclose contemplation of a technical change in the hardware or software using in the working environment of the organization (e.g., implementation of a new software application, installation of new hardware, etc). Rather, the potential solutions or improvements of Guinta are nondescript and do not specify that they are technical changes in the working environment. Furthermore, the changes described in Curtis relate to greater levels of maturity in technical processes for developing software. To this extent, the changes, if any, in Curtis are relegated to processes for developing software and, as such, are not technical changes to hardware or software that is used in the working environment. In contrast, the claimed invention includes “...in preparation for implementing a pre-determined proposed technical change in hardware or software used in a working environment of the

organization.” Claim 1. As such, in contrast to Guinta, the querying, quantifying, modifying and comparing steps of the claimed invention (or at least the querying step) are performed prior to and in preparation for implementing the technical change in the hardware or software is used in the working environment of the organization. Thus, Guinta does not teach each and every feature of the claimed invention. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With further respect to independent claims 1, 15 and 23, Applicants respectfully submit that the cited references also fail to teach quantifying the baseline response into a raw score by automatically assigning a value to each baseline response. In support of its position to the contrary, the Office cites various passages of Guinta. These passages of Guinta teach various ways for its assessor to initially answer a question, such as: entering a value on an analog scale (col. 8, lines 15-20), a numerical input that is utilized to indicate specific events or circumstances (col. 9, lines 52-53), and a sliding scale with which a numerical input may be selected (col. 5, lines 33-37). To this extent, Guinta teaches that the initial input that is supplied by the first assessor may be of various types. However, each of the values in the examples from Guinta provided by the Office are entered initially by its assessor and not later automatically assigned to the original baseline response. To this extent, Guinta does not teach that its assessor in any way quantifies the originally given response by automatically assigning a value to the previously given response.

In contrast, the claimed invention includes “...quantifying the baseline response into a raw score by automatically assigning a value to each baseline response.” Claim 1 and similarly in claims 15 and 23. As such, in contrast to the various types of responses Guinta that include

a user entered percentage value on a 0-100 scale, the claimed invention quantifies the baseline response into a raw score by automatically assigning a value to each baseline response. For the above reasons, the automatic quantifying of the baseline response of the claimed invention is not taught by the various input types of Guinta. Curtis does not cure this deficiency. Accordingly, Applicants respectfully request that the rejection of the Office be withdrawn.

With still further respect to independent claims 1, 15 and 23, Applicants respectfully submit that the cited references also fail to teach or suggest modifying the raw score using at least one modifier that relates to how responsive members of the hierarchy traditionally are to change to yield a skill score. Initially, as stated above, Guinta does not teach the raw score that is automatically generated by quantifying a baseline response, as in the claimed invention. Further, the passage of Guinta cited by the Office teaches that “[t]he numerical input shown in FIG. 4 may be modified based on a wide variety of factors preferred by the apparatus designers.” Col. 9, lines 44-49. However, Guinta teaches that the modifying and filtering illustrated in FIG. 4 has the purpose of “...inhibiting validation/collection of exaggerated, untrue, and/or unsupported numerical inputs.” Col. 9, lines 40-41. The Office further cites a discussion that it indicates that its second input indicates the capability of an organization process or system to address an issue. Col. 6, lines 49-63. However, this passage does not indicate that this indication is based on how responsive members of the hierarchy traditionally are to change, but rather “how extensively the organizational process or system is actually [presently] deployed to address that issue.” Col. 6, lines 54-56. The claimed invention, in contrast, includes “...modifying the raw score using at least one modifier that relates to how responsive members of the hierarchy traditionally are to change to yield a skill score.” Claim 1. As such, the modifying of the claimed invention is not

merely intended to assess the present deployment of an organization system or process as in Quinta, but rather uses at least one modifier that relates to how responsive members of the hierarchy traditionally are to change. For the above reasons, Quinta does not teach the modification step of the claimed invention. Accordingly, Applicants request that the rejection be withdrawn.

With yet still further respect to independent claims 1, 15 and 23, Applicants respectfully submit that the cited references also fail to teach or suggest comparing the skill score to a predetermined required score to determine a predicted response to the technical change prior to implementing the technical change in the organization. The Office admits that Quinta does not teach this feature of the claimed invention. Instead, the Office relies on Curtis. However, as stated elsewhere herein, Curtis does not relate to a technical change in the hardware or software used in the working environment of an organization, as does the claimed invention. Accordingly, Applicants request that the Office's rejection be withdrawn.

D. REJECTION OF CLAIMS 2, 7-10, 14, 16, 22, 24, 27 AND 31-33 UNDER 35 U.S.C. §103(a) OVER GUINTA IN VIEW OF CURTIS

Appellants initially incorporate the above-enumerated arguments. Additionally, in the above referenced Final Office Action, the Examiner alleges that Quinta teaches or suggests recommending a corrective action based on the predicted response. As stated herein, Quinta does not teach predicting a response to a *pre-determined proposed* change, but rather identifying and resolving a current problem. As such, the "...suggest[ing of] guidelines for the organization to improve the weaknesses" of the cited passage of Quinta suggests guidelines to improve current weaknesses identified by Quinta and is not based on a predicted response to change as in the

claimed invention. Thus, the cited references do not teach or suggest each and every feature of the claimed invention. Accordingly, Applicants respectfully request withdrawal of the rejection.

E. REJECTION OF CLAIMS 6, 13, 20 AND 29 UNDER 35 U.S.C. §103(a) OVER GUINTA IN VIEW OF CURTIS

Appellants initially incorporate the above-enumerated arguments. Additionally, Applicants respectfully submit that the cited references fail to teach or suggest that each query comprises a set of questions, with each question in the set of questions in a yes/no/sometimes format. The Examiner admits that neither Guinta nor Curtis teaches a yes/no/sometimes format, much less that each question in the set of questions is in a yes/no/sometimes format. Final Office Action, page 20. The Office informally provides Ahmed (U.S. Patent Pub. No. 2001/0107824) as a reference in the Office Action, but does not Officially Cite the reference as part of the rejection under 35 U.S.C. §103(a). Instead, the Examiner takes Official notice that “...it is old and well known in the art for queries to have an answer as ‘sometimes’.” Final Office Action, page 20. Appellants assert that the Examiner’s factual assertion is not properly based upon common knowledge. For example, Appellants assert that a query of an organization to obtain a baseline response used to determine a predicted response to a technical change in the organization, wherein each question in the query is in a yes/no/sometimes format is not obvious to one skilled in the art as asserted by the Examiner. Accordingly, the Examiner has failed prove a *prima facie* case of obviousness.

F. OTHER REJECTIONS UNDER 35 U.S.C. §103(a)

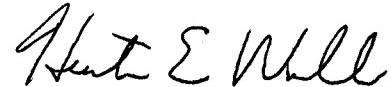
With regard to the Office's other arguments regarding dependent claims, Applicants herein incorporate the arguments presented above with respect to independent claims listed above. In addition, Applicants submit that all defendant claims are allowable based on their own distinct features. However, for brevity, Applicants will forego addressing each of these rejections individually, but reserve the right to do so should it become necessary. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

IV. CONCLUSION

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



Date: March 12, 2007

Hunter E. Webb
Reg. No.: 54,593

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

RAD/hew